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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
Oshima, et. al.
Application No. 09/672,948
Filed: September 29, 2000
Attorney Docket No. 2000-1327

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DECISION GRANTING
PETITION UNDER
37 CFR §1.183

This is a decision on the June 4, 2004, "Petition Under 37 CFR 1.183 to Accept Substitute Specification in Reissue Application" requesting waiver of the 37 CFR 1.125(d) prohibition against the filing of a substitute specification in a reissue application. The petition is being treated pursuant to 37 CFR 1.183 for waiver of 37 CFR 1.173(a)(1) in addition to waiver of 37 CFR 1.125(d).

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is granted.

A fee of \$130.00 has been charged to Deposit Account No. 23-0975 for the petition under 37 CFR 1.183, as authorized by the petition on page 1.

DECISION

37 CFR 1.125(d) prohibits the filing of a substitute specification in a reissue application, while the present petition requests entry of the substitute specification filed on July 16, 2003. Accordingly, this petition is being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.125(d). 37 CFR 1.173(a)(1) requires the filing of the specification in the form of "a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper." The substitute specification filed on July 16, 2003, is not a copy of the printed patent, in double column format. Accordingly, this petition is also being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.173(a)(1).

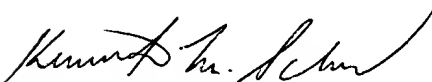
On July 16, 2003, a substitute specification was filed together with a request for reconsideration of an outstanding Office action. There was no explanation provided with the submission of the substitute specification as to the reason for its submission. It is also noted that there is no further comment by the examiner, regarding the substitute specification, noted in the application.

Petitioner is now requesting waiver of the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) based on the fact that "In several of the applications, the Examiner required a substitute specification because of the length of the specification and the number of amendments, and indicated by telephone that substitute specifications would be required in all of the related reissue applications."¹ The petitioner continues by stating "...in the parent reissue application 09/244,037 the replacement paragraph amendments were filed on April 30, 2003. Then in the Office Action mailed July 29, 2003, the Examiner required a substitute specification. Also in related reissue application 09/662,695, which like the present application is a reissue application of U.S. Patent 5,600,672 and a divisional application of reissue application 09/244,037, the replacement paragraph amendments filed on May 7, 2003 were denied entry and a substitute specification was required in the Office Action mailed May 27, 2003."

This basis is considered to be sufficient for granting the petition. The rule will be waived, since there is no other way to present the substitute specification required by the examiner in the companion applications, and that requirement for the substitute specification by the examiner is deemed appropriate.

CONCLUSION

1. The request under 37 CFR 1.183 to waive the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) is granted.
2. The substitute specification filed on July 16, 2003 is accepted, and will be entered.
3. The reissue application file is being forwarded to Technology Center 2600 for further action as appropriate.
4. Telephone inquiries with regard to this decision should be directed to Dwayne D. Bost, TC2600 SPRE, at (703) 305-4778.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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¹ No other record of the referenced telephone conversation can be found in this application file.